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09/754,086	01/05/2001	Nobuhiro Shoji	001763	4704

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EXAMINER

LE, KHANH H

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/754,086

Applicant(s)

SHOJI ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **Detailed Action**

1. This Office Action is responsive to the Amendment and Response dated November 30, 2004.

Claims 1- 27 were pending in the present application. Claims 19-27 are cancelled  
Claims 1-18 are now pending, with claims 1, 9, 15 as independent claims.

### **Priority**

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 08/25/2000. Acknowledgment is made of applicant's filing of a certified copy of the foreign application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC §101***

3. The rejections as to claims 1, 23-26 are withdrawn as a result of the amendments.

### ***Double Patenting***

4. The rejection as to claims 16 and 19 are withdrawn as claim 19 is cancelled.

### ***Claim Rejections - 35 USC § 112***

5a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**5b. Claim 1 and all its dependents (2-8) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Claim 1:

Step (i) states : “said first server transmitting the information that is exchanged from said first points to the second points which are issued from the third server to said second server.

If Applicants mean to claim “transmitting ...the information... to said second server”, this feature is not supported by the Specifications.

In the absence of proper support for this step and also the confusing language involved (see more discussion at p. 6), The Examiner would have to engage in substantial speculation to figure out how the invention is practiced, in determining the scope of the claim because the method step i) was not presented in the specification . What process step is meant by the language of step i) would be speculative Thus any art rejection would have to be based on unsupported speculative assumptions. . Since there is substantial guesswork involved , no prior art will be applied to step i).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

As to claims 19-22, 23-25 withdrawn as moot.

**7. Claims 1, 9, 15 and all their dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

**8. At least claims 1-2, 9, 15 are utterly confusing. Appropriate correction and /or revision is required as to all claims.**

As to claim 1 (Currently amended), it reads as follows. The confusing languages, either because of bad grammar, idiomatic English, lack of antecedent, or internal contradiction are set **in bold**. The Examiner is attempting to make sense of the claim by indenting the phrases as follows. Please note that at least step c) should be redrafted as a positive step.

A method for exchanging point

issued by various sources comprising the steps of:

(a) accessing a first server by forming a communication link by a terminal computer of a consumer

(b) said first server making said terminal computer display in responding to

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said accessing

**the other** form of point different from a first point **A possesses** and an exchange rate;

(c) an identification information which concerns the number of said first points which are desired to be exchanged, the other form and

**possessing** said first point being inputted into the first server:

d) said first server forming a communication link with a second server which issues the first points and referring to the possession right of said first points;

(e) said second server assigning the possession right of the first points to said first server after confirming the possession right based on the identification information;

f) said first server obtaining a total number of points based on said exchange rate.,  
forming a communication link to a third server who issues originally **a second points the consumer desires to be exchanged and requesting to obtain a designated number of points;**

g) said third server confirming if the requested second points are possessed  
**when possessed, requesting (who? the consumer? how can third server request the consumer if not in direct contact with the consumer? there seems to be a missing essential step here) to select** the identification information in order to make use of the second points of said third server through the first server from said terminal computer,

h) said third server receiving said  
selected identification information of making use of the second points of said third server from said terminal computer and giving said second points;

(i) said first server **transmitting** the information that is exchanged from said first points to the second points which are issued from the third server **to said second server.**

**Examples of questions raised by the confusing language:**

step f) states “**a second points the consumer desires to be exchanged and requesting to obtain a designated number of points**”. It is noted “to be exchanged” should be ‘exchanged into’; further, it’s unclear who is doing the “requesting”, the consumer, the first or third server? . Further, are the points in “a designated number of points” the same as those in “a total number of points”? Are points in “a total number of points” intermediate points? If so, it should be stated. If not, step f) is internally inconsistent as the “obtaining” “a total number of points” seems to be accomplished before establishing the communication link to the 3<sup>rd</sup> server. Claim 2 seems to indicate that the “a total number of points” here does not mean intermediate points, however, both claims are utterly confusing and appropriate correction is required.

Step i): It is not clear what “the information that is exchanged from said first points to the second points” means. In addition to the lack of support, (see above) this confusing language makes application of prior art impossible.

**Claim 9 suffer substantially of the same defects as claim 1.**

As to claim 2 (currently amended), it reads as follows. The confusing languages, either because of bad grammar, idiomatic English , lack of antecedent, or internal contradiction are set **in bold**.

“The method of claim 1, when said first server obtaining the total number of point based on exchanging rate shown to said consumer, **based on the exchanging rate shown to said consumer**, based on the exchanging rates of said first point and an intermediate point after being exchanged to said intermediate point., such total number of point is obtained by being exchanged to said second point based on the exchanging rates of the intermediate point and the second point.

Note:

1) “based on the exchanging rate shown to said consumer” is repeated twice.

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2) “the total number of point” is unclear : is it the intermediate points? or the final exchange points?

3) *“obtaining the total number of point based on exchanging rate shown to said consumer.. based on the exchanging rates of said first point and an intermediate point after being exchanged to said intermediate point, such total number of point is obtained by being exchanged to said second point based on the exchanging rates of the intermediate point and the second point”* : it is unclear from this language how the exchange is done. It seems the first point are converted into a number of intermediate points, then these intermediate points are converted to a number of second points based on an exchange rate between the intermediate points and the second points. However, how exactly is this process done remains unclear from claim 2 as drafted.

As to claim 15, it reads as follows and is virtually incomprehensible. The confusing languages, either because of grammar, idiomatic English , lack of antecedent, or internally contradictory are set in bold.

“A card comprising a recording medium  
 recording usable point number which is made readable on **the** terminal computer and  
 corresponding of **the** consumer's usable amount of money,  
 a **first information** and  
 recording a URL information proper to the first information,  
 said recording medium further comprising a program which  
 makes said point number and an advertising information **read out and for** the terminal  
 computer when attaching to **the terminal** of the terminal computer **displayed on the display**.  
**makes** the server corresponding to the URL information corresponding to **the**  
**advertising**  
 selected by the consumer **accessed**.

makes **the** recent usable point number obtained by the server **by operating of** the point



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**number corresponding to the accessing process in addition received from the corresponding server.**

**makes the usable point number recorded before the operation renewed to the received recent usable point number.**

For example, “the terminal computer” , “**the** consumer's usable amount of money” lack antecedent basis.

Is “the advertising” the same as the first information since the Url refers to both the 1<sup>st</sup> information and the advertising? How does the consumer select the advertisement i.e. there is a missing essential step ?

the last two steps of this claim suffer from all: grammar, idiomatic English , lack of antecedent, missing essential steps and/or internally contradictory.

### **Response to Arguments**

9. Due to the confusing language of claim 1, claims 1 and 2 are hereby interpreted as the substantial equivalents of the previously presented claims 1 and 2, with the addition of the last step i) (to which no prior art can be applied) and the use of “intermediate exchange points” in step f).

Thus claims 1 and 2 are now rejected under 35 U.S.C. 103(a) as being unpatentable over Sakakibara, US 6721743 B1, herein Sakakibara, (as previously discussed for previously presented claims 1 and 2), and further in view of “ International Barter Corp., Changes Name to Ubarter.com; Name Change Reflects Move to E-Commerce Model”, Business Wire, April 27, 1999, Dialog File 20, record # 05110080 herein “Ubarter .

Ubarter discloses an Internet barter system of goods and services using “Ubarter dollars” as intermediate exchange medium(see full 5th paragraph).

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It would have been obvious to one skilled in the art at the time the invention was made to add Barter's idea of a universal trading medium of exchange to Sakakibara's point exchange system to facilitate the exchange in the same manner as taught by Ubarter.

**10. No Application of the prior art to claim 15 and its dependents**

In *Re Steele*, 134 USPQ 292, held that an art rejection should not be applied when there is substantial guesswork involved in determining the scope of the claim or substantial confusion as to the interpretation of the claims because such rejection would be based on unsupported speculative assumptions (excerpt follows).

*("Our analysis of the claims indicates that considerable speculation as to meaning of the terms*

*employed and assumptions as to the scope of such claims were made by the examiner and the board. We do not think a rejection under 35 U.S.C. 103 should be based on such speculations and assumptions. ....it is essential to know what the claims do in fact cover. As we have previously indicated, our analysis of the claims leaves us in a quandary as to what in fact is covered by them.*

*We think the examiner and the board were wrong in relying on what at best are speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. 103 thereon.*

*Our study of the lengthy record of the Patent Office prosecution provides ample support for our*

*conclusion that substantial confusion exists in the record at all levels of the prosecution as to the proper interpretation to be given to the appealed claims. We believe that this confusion arose and has continued because the claims do not particularly point out and distinctly claim the invention as required by 35 U.S.C. 112.*

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*We therefore have decided to resolve the issue herein by reversing the decision below because we find it based on unsupported speculative assumptions. “)*

Thus no prior art is applied to claims 15 and its dependents in the instant case.

***Claim Rejections - 35 USC §102***

11a. As to Claims 1, 3-7, 9, 10-12,14, withdrawn due to the amendments.

As to claims 26, 27 withdrawn as moot.

***Claim Rejections - 35 USC § 103***

11b. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11c. **Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakakibara, US 6721743 B1, herein Sakakibara further in view of “ International Barter Corp., Changes Name to Ubarter.com; Name Change Reflects Move to E-Commerce Model”, Business Wire, April 27, 1999, Dialog File 20, record # 05110080, herein “ Ubarter”.**

As to claims 1-2 (interpreted as discussed above), 9, 10, Sakakibara discloses (as discussed in the last Office Action at pages 7-8),

method, system, computer programs for at least one consumer to exchange points issued by various sources comprising the steps of:

a) accessing a first server (see at least Fig. 7A and B, central unit 10, and associated text),

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b) displaying an exchange rate of points between said consumer's points and at least one other form of points (see at least Fig. 4 and associated text),

c) by use of said first server, said consumer selecting which points they wish to convert said consumer's points into of any of the points available (see at least Fig. 7B steps S101, 102, and associated text: user chooses available communication points)

d) consumer informing said first server of said consumer's decision to convert said consumer's points to said points available (see at least Figs 7A, communication from user terminal to central unit 10 and associated text),

e) said consumer inputting any identifying information (interpreted as authentication information: (see at least Figs. 7A , items S101 and S102 and associated text) that consumer uses for said consumer's points),

f) said consumer to provide information that said consumer wishes to use as identifying information in relation to said points available ( it is interpreted the user gives at least his name which he has in steps S101 and S102 of Fig. 7A),

g) converting said points of said consumer to points of that said available points based on said exchange rate (see at least Figs. 4, 7A, B, and associated text), and

h) providing said consumer with said available points (see at least Figs. 7B, item S112 and associated text).

Further, (as discussed in the last Office Action at pages 9-10 in connection with previously presented claim 2) Sakakibara discloses converting further comprises:

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a) forming a communication link between said first server and a second server which issued said consumer's points (see at least Figs. 7A and B and associated text),

c) communicating to second server said identifying (authentication) information of said points (see at least Figs. 7A and B and associated text),

d) allowing said second server to assign ownership of said consumer points to said first server (see at least Figs. 7B step S108, S109 and associated text),

As to steps b), e), f), g),

b) forming a communication link between said first server and a third server which issued or can issue points which said consumer seeks,

e) communicating from said first server to said third server a request to assign said sought points,

f) communicating from said first server to said third server a request to record said new identifying information in assigning said available points, and

g) receiving from said third server confirmation that said available points have been assigned in the event that assignment is successfully carried out.

Figs. 7A and B show the central server acting also as the issuer of the sought points and filling all the steps as above-claimed. Official Notice was taken (**see LAST OFFICE ACTION at page 10, 2<sup>nd</sup> full paragraph**) that it is well-known to split computing functions onto many servers as the system configuration requires. Thus it would have been obvious to one skilled in the art at the time the invention was made to split the functions performed by Sakakibara's central unit 10 to another server for ease of computing.

**Note: The Official Notice was unchallenged and therefore taken as admitted. See MPEP 2144.03.**

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As to exchanging the first points into intermediate points then the intermediate points into the second points, Sakakibara does not disclose such. However using an intermediate exchange medium to facilitate trading of different goods and services is well-known. One well-known intermediate exchange medium system is cash. Others are disclosed, for example in articles such as "Ubarter", which discloses an Internet barter system using "Ubarter dollars" as intermediate exchange medium.

It would have been obvious to one skilled in the art at the time the invention was made to add Ubarter's idea of a universal trading medium of exchange to Sakakibara's points exchange system to facilitate the exchange of such points, in the same manner as taught by Ubarter.

As to claims 3, 4, 11 (dependent on claims 1 and 9, respectively), Sakakibara discloses said second points comprise points from purchases using a credit card or mileage points (see at least Fig. 4 "airline" and associated text).

As to claims 5, 12, (dependent on claims 1 and 9, respectively), Sakakibara discloses the sought second points comprise units for payment of pre-paid access to network sites (see at least abstract: "communication points").

As to claims 6, 7, Sakakibara discloses wherein said accessing step is conducted via a network, the Internet.

As to claims 14. (dependent on claim 9), Sakakibara inherently discloses at least one server and at least one database which can issue points of different classes and different names (see at least Fig. 4 and associated text).

As to claims 8, 13 (dependent on claims 1 and 9, respectively), Sakakibara does not specifically disclose providing points with time limitations on their use and erasing information of ownership of said points with time limitations upon expiration of said time limitation. However, Official Notice was taken (see **LAST OFFICE ACTION** at page 10,

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**last paragraph)** that it is well-known to provide limited time points which expire automatically (ownership is inherently erased thereby). It would have been obvious to one skilled in the art at the time the invention was made to add such ‘available points’ to the ones cited by Sakakibara to extend Sakakibara’s system to those “available points” participants who so desire consistent with their business plans.

**Note: The Official Notice was unchallenged and therefore taken as admitted. See MPEP 2144.03.**

### **Conclusion**

12. Prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

“Hilton HHonors Worldwide Adds Japan Airlines, Sixt Rent A Car and LanChile Airlines as Travel Partners, Business Wire , April 07, 1998, Dialog File 20, # 01344967 discloses promoting and managing a frequent flyer mileage exchange program.

**“ International Barter Corp., Changes Name to Ubarter.com; Name Change Reflects Move to E-Commerce Model”**, Business Wire, April 27, 1999, Dialog File 20, record # 05110080

Kanter, US Patent 5537314, discloses *a universal trading system (cash) system*.

Odom et al, US 6058379, discloses an electronic barter system and method (col 22-45) conducted on the Internet

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: [khanh.le2@uspto.gov](mailto:khanh.le2@uspto.gov). (However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

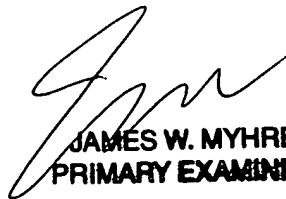
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. (After our Art Unit moves to the Alexandria campus, sometime during or after April 2005, the Examiner's phone number will be 571-272-6721 and Mr. Eric Stamber's will be 571-272-6724. The current numbers are still in service until the move). The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

February 15, 2005

KHL

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JAMES W. MYHRE  
PRIMARY EXAMINER